

REMARKS/AGRUMENTS

Reconsideration of this application is respectfully requested. No new matter has been added. The claims are patentable over the cited art of record.

Claims 1-12 and 14-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,295,513 B1 of Thackston ("Thackston") in view of U.S. Patent No. 5,970,471 of Hill ("Hill"), and further in view of U.S. Patent No. 5,826,244 of Huberman ("Huberman"). Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,295,513 B1 of Thackston ("Thackston") in view of U.S. Patent No. 5,970,471 of Hill ("Hill"), in view of U.S. Patent No. 5,826,244 of Huberman ("Huberman"), and further in view of U.S. Patent No. 5,930,810 of Farros et.al ("Farros"). These rejections are respectfully traversed, because (i) the Office Action fails to establish a prima facie case of obviousness, and (ii) the combination does not teach each and every element of the invention as claimed.

I. The 35 U.S.C. 103(a) rejection of claims 1-22 was erroneous, because the Thackston reference, on its face, is not eligible prior art against the present application

All of the present rejections rely on the disclosure in Thackston. However, the Thackston reference has a filing date of October 1, 1999, which is after the filing date of the present application (June 9, 1999). Thus, the Thackston reference (on its face) is not eligible prior art against the present application and so the present rejections should be removed.

To the extent the Examiner is relying on disclosure that was contained in one or more of the parent application of Thackston (Appln. nos. 09/270,007 and 09/311,150), which have filing dates earlier than that of the present application, the Office Action has not established that the material being cited in support of the present rejection is entitled to one or more of those earlier

fling dates. Without setting forth such evidence (either by providing copies of the parent applications or by suitable declaration), the Office Action has failed to establish a prima facie case of obviousness and, consequently, the rejections should be removed.

II. The 35 U.S.C. 103(a) rejection of claims 1-22 was erroneous, because there is no suggestion or motivation to combine Thackston and Huberman, with Hill or Farros

Even if the Thackston reference is properly considered prior art to the present application, there is no suggestion/motivation to combine Thackston and Huberman with Hill. Thackston and Huberman are directed at providing a mechanism to collect bids from different vendors for a pre-defined job (Thackston, 4:29-34, Huberman, 3:52-58). Hill, on the other hand, is directed at solving the product merchandising problem by providing a virtual product catalog to the customer (Hill, 1:10-20). The product merchandising problem addressed by Hill is distinct and unrelated to providing a mechanism to collect bids from different vendors for a pre-defined job of Thackston and Huberman (Thackston, 4:29-34, Huberman, 3:52-58). Thus, there is no suggestion or motivation to combine Thackston and Huberman, with Hill.

There is no suggestion or motivation to combine Thackston and Huberman with Farros. Thackston and Huberman are directed at providing a mechanism to collect bids from different vendors for a pre-defined job (Thackston, 4:29-34, Huberman, 3:52-58). Farros, on the other hand is directed at enabling a customer to define a product provided by a particular vendor by choosing a category of a product along with selecting a desired layout (Farros: 9:23-32), without having an opportunity to receive a bid from any other vendor. Because Farros is directed at a distinct and unrelated objective from Thackston and Huberman, there is no suggestion or motivation to combine Thackston and Huberman with Farros.

III. The 35 U.S.C. 103(a) rejection of claims 1-22 was erroneous, because the references relied upon in the Office Action do not teach every element of the claims at issue

Even if Thackston, Huberman, and Hill are combined, the combination fails to disclose “comparing a plurality of vendor specific instances of an electronic print job request object within a combined view, each vendor specific instance of the print job request object to represent a relationship between a customer and one of a plurality of vendors to perform a print job project, each vendor specific instance of the print job request object defined through a series of iterative customer submissions and vendor responses to allow the customer to select one of the plurality of vendors to perform the print job project” as required by claim 1.

The Huberman reference discloses the provision of document services by suppliers, such as professional print shops or publishers or in-house corporate or government document services departments, to customers, such as individuals, companies, or corporate or government departments (see Huberman, 3: 40-45). The Hill reference discloses the presenting of product images for review by a user on a computer (see Hill – Abstract). However, neither the Huberman nor the Hill references disclose the features recited above.

1. The feature of iterative customer submissions and vendor responses is not inherent in negotiation process disclosed in Thackston

Claim 1

The Office Action relies on Thackston to teach “comparing a plurality of vendor specific instances of an electronic print job request object ... , each vendor specific instance of the print job request object to represent a relationship between a customer and one of a plurality of vendors to perform a print job project, each vendor specific instance of the print job request object defined

through a series of iterative customer submissions and vendor responses to allow the customer to select one of the plurality of vendors to perform the print job project” as required by claim 1.

Although Thackston discloses the “server system configured to allow business transactions pertaining to the engineering development effort to be carried out in the virtual environment, such as negotiations, contracting and funds transfer” (Thackston, 13:1-5), it does not necessarily suggest “iterative customer submissions and vendor responses” as required by claim 1. For example, the “negotiations” disclosed in Thackston (Thackston, 13:1-5) may include 1) the original submission by a prime contractor to a supplier, 2) allowing a supplier to add terms to the original submission, the terms selected from a database of standard terms and conditions (Thackston, 25: 39-40) and 3) provide a bid based on the added terms rather than on original submission. At this point the prime contractor may accept the bid without making another submission. By the same token, the supplier may be unable to provide another bid or continue negotiations in any other manner. Because the supplier had one opportunity to modify the terms of the original submission, the process of negotiation took place. On the other hand, this example illustrates that the “iterative customer submissions and vendor responses” are not inherent in order to engage in business transactions and negotiations to finalize the contract.

Thus, Thackston does not disclose a vendor specific instance of the print job request object defined through *a series of iterative customer submissions and vendor response* as required by claim 1. Therefore, claim 1 and its dependent claims are allowable in view of Thackston, whether considered separately or in combination with Huberman and Hill. Therefore, the combination of references does not teach or suggest that “each vendor specific instance of the print job request object” is “defined through a series of iterative customer submissions and vendor responses,” as recited in claim 1.

Claims 5, 15, and 21 and their dependent claims are allowable for at least the reasons articulated with respect to claim 1.

2. **The Office Action failed to specifically address the element of claim 5, where “one or more constraints on one of the vendor specific instances of the print job request object are added, removed and/or modified during each iteration”**

Claim 5

In addition to the arguments articulated with respect to claim 1, Thackston fails to disclose “permitting the customer to compare ... , in an initially under-constrained fashion, each vendor specific instance of the print job request object and further permitting the vendors and the customer to successively develop each vendor specific instance of the print job request object to a fully-constrained form through *an iterative process in which one or more constraints on one of the vendor specific instances of the print job request object are added, removed and/or modified during each iteration*” as required by claim 5. The Office Action failed to specifically address the element of claim 5, where “one or more constraints on one of the vendor specific instances of the print job request object are added, *removed and/or modified* during each iteration”. Although Thackston discloses that suppliers may use contract “templates” as a starting point for creating an agreement (Thackston, 13:11-14), there is no indication in Thackston that the constraints initially present in a template may be “*removed and/or modified*” as required by claim 5.

Because the reference relied on by the Office Action does not disclose each and every element of claim 5, claim 5 and its dependent claims are allowable in view of Thackston, whether considered separately or in combination with Huberman and Hill.

Claim 15 and its dependent claims are allowable for at least the reasons articulated with respect to claims 1 and 5.

**3. The rejection of claim 13 was erroneous, because the Thackston/ Huberman/
Hill/Farros combination fails to teach each and every element of claim 13**

Claim 13

Neither Thackston, nor Huberman, nor Hill, nor Farros teach a “vendor specific instance of a print job request job object, the print job request object comprising a different pricing structure for each vendor based on at least bindings, covers, and delivery schedules” as required by claim 13.

The Office Action cites Huberman to disclose that “characteristics like bindings, delivery schedules, and etc. to have different pricing structure from different vendors” (Detailed Action, p. 5). In Huberman, a customer provides the particulars of the job to a print shop, and is quoted a price for printing, binding and delivering the finished documents. The customer may obtain a second price quote from a competing print shop. (Huberman, 2: 38-43). The suppliers in Huberman may submit bids to a broker who auctions the job (Huberman, 3: 52-58). Thus, the bids may reflect different pricing for each vendor based on the particulars of the print job, initially provided by the customer. This is distinct, however, from a “vendor specific instance of a print job request job object” as required by claim 13. Furthermore, the possibility of different price quotes from different suppliers in Huberman is distinct from “a different pricing structure for each vendor based on at least bindings, covers, and delivery schedules” as required by claim 13.

The Office Action relies on Farros to teach “a different pricing structure for each vendor based on ... covers” as required by claim 13. Farros is directed at enabling creation of a variety of printed products (Farros, Abstract). A user may choose a category of product (e.g., business cards), and then choose and modify a layout within the category (Farros, 9:23-32). Each layout (or a form) is described in a separate format definition file (FDF) (Farros, 9:23-32). Although

Farros discloses that a layout may include components that represent "faces" of the form such as cover, inside, and back cover (Farros, 9:33-47), there is no indication in Farros that the pricing structure may be based on cover. There is nothing in Farros to suggest that the pricing structure for a service is not determined solely on the basis of the category of product without taking into consideration the "face of the form such as cover". This is in stark contrast with "a different pricing structure for each vendor based on ... covers" as required by claim 13.

IV. Conclusion

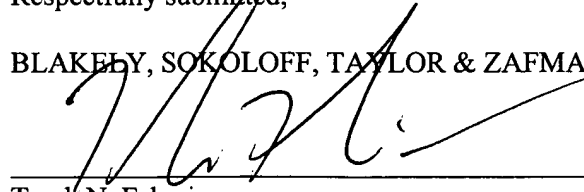
It is respectfully submitted that in view of the remarks set forth herein, the applicable rejections have been overcome.

If there are any additional charges, please charge Deposit Account No. 02-2666 for any fee deficiency that may be due.

Respectfully submitted,

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